

FORM PTO-1390  
(REV. 11-94)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTORNEY'S DOCKET NUMBER

10925-003-999

**TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)****09/889029**INTERNATIONAL APPLICATION NO.  
PCT/DE00/00072INTERNATIONAL FILING DATE  
5 January 2000PRIORITY DATE CLAIMED  
8 January 1999TITLE OF INVENTION  
**DEVICE FOR SEPARATING FLUIDS****JC14 Rec'd PCT/PTO 06 JUL 2001**APPLICANT(S) FOR DO/EO/US  
Troubounis *et al.*

Applicant herewith submits to the United States Designated/ Elected Office (DO/EO/US) the following items under 35 U.S.C. 371:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☒ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☒ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
  - a. ☒ is transmitted herewith (required only if not transmitted by the international Bureau).
  - b. ☐ has been transmitted by the International Bureau.
  - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US)
6. ☒ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
  - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ have been transmitted by the International Bureau.
  - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
  - d. ☐ have not been made and will not be made.
8. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)) (executed).
10. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

**Items 11. to 16. below concern document(s) or information included:**

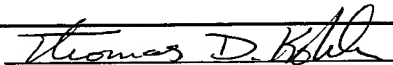
11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A **FIRST** preliminary amendment.  
☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☒ Other items or information:

Unexecuted Declaration;  
Written Opinion and translation;  
Response to Written Opinion with amendments and translation;  
International Search Report;  
International Preliminary Examination Report; and  
Return Post Card.

17. ☒ The U.S. National Fee (35 U.S.C. 371(c)(1)) and other fees as follows:

CLAIMS				
(1)FOR	(2)NUMBER FILED	(3)NUMBER EXTRA	(4)RATE	(5)CALCULATIONS
TOTAL CLAIMS	25 - 20	5	X \$ 18.00	\$ 90.00
INDEPENDENT CLAIMS	1 - 3	0	X \$ 80.00	0.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			+ \$ 270.00	□
BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(5)): <b>CHECK ONE BOX ONLY</b>				
<input type="checkbox"/> International preliminary examination fee paid to USPTO (37 CFR 1.482) ..... \$ 690				
<input type="checkbox"/> No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee paid to USPTO (37 CFR 1.445(a)(2)) ..... \$ 710				
<input type="checkbox"/> Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO ..... \$1000				
<input type="checkbox"/> International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(2) to (4) ..... \$ 100				
<input checked="" type="checkbox"/> Filing with EPO or JPO search report ..... \$ 860				\$ 860.00
Surcharge of \$130.00 for furnishing the National fee or oath or declaration later than 20 30 mos. from the earliest claimed priority date (37 CFR 1.492(e)).				
TOTAL OF ABOVE CALCULATIONS			=	950.00
Reduction by 1/2 for filing by small entity, if applicable. Affidavit must be filed also. (Note 37 CFR 1.9, 1.27, 1.28).				- \$ 475.00
SUBTOTAL			=	475.00
Processing fee of \$130.00 for furnishing the English Translation later than 20 30 mos. from the earliest claimed priority date (37 CFR 1.492(f)).				+
TOTAL FEES ENCLOSED			\$	475.00

- a. ☐ A check in the amount of \$\_\_ to cover the above fees is enclosed.
- b. ☒ Please charge Deposit Account No. 16-1150 in the amount of \$ 475.00 to cover the above fees (order no. 10925-003-999). A copy of this sheet is enclosed.
- c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 16-1150. A copy of this sheet is enclosed.

18. ☐ Other instructions  
n/a19. ☒ All correspondence for this application should be mailed to  
PENNIE & EDMONDS LLP  
3300 Hillview Avenue  
Palo Alto, CA 9430420. ☒ All telephone inquiries should be made to (650) 493-4935Thomas D. Kohler  
NAME  
SIGNATURE32,797  
REGISTRATION NUMBERJuly 6, 2000  
DATE

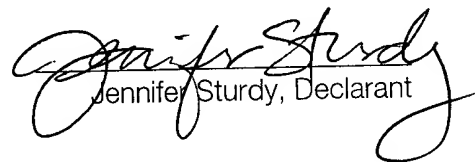


Declaration of Jennifer Sturdy

I, Jennifer Sturdy of TransPerfect Translations, Inc., was contacted by Ms. Susan Keyser of Pennie & Edmonds LLP to perform a translation from German into English. I have personal knowledge of the facts set forth below:

I hereby certify that the following document is, to the best of my knowledge and belief, a true and accurate translation of the Fluid Separating Apparatus document.

I declare under penalty of jury under the laws of the State of California the foregoing is true and correct. Dated this 5<sup>th</sup> day of July 2001.

  
Jennifer Sturdy, Declarant

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**LEWINSKY & PARTNER\***  
 PATENT ATTORNEYS AND ATTORNEYS  
 GOTTHARDSTRASSE 81 • D-80689 MUNICH  
 GERMANY

\* Partnership under the Civil Code  
 Dipl.-Ing. Dietrich Lewinsky, Patent Attorney<sup>1</sup>  
 Klaus Lewinsky, Attorney<sup>3</sup>  
 Dipl.-Ing. Michael Rasch, Patent Attorney<sup>1, 2</sup>  
 MARCOPAT®  
 E-mail: lewinsky-partner@t-online.de

European Patent Office  
 Erhardstr. 27  
 80298 Munich

**Our reference**  
 – Please always quote –  
**32.821 MR/ha**

Your reference  
PCT/DE 00/00072

Your letter

Date  
 March 1, 2001

Meri Entsorgungstechnik für die Papierindustrie... et al.

**In reply to the office action of 11/2–11/3/2000:**

In reply to the office action of 11/2/2000 we are submitting

- new claims 1, 4 and 12 and
  - an amended introduction to the description with pages 1, 2, 3 and 3a
- on which the further examination procedure should be based together with the other originally filed claims. Deletions are ~~crossed out~~ and additions are underlined.

**Changes in the Claims**

The changes in claims 4 and 12 are purely formal in nature.

Claim 1 was editorially revised taking into account points 1.1, 1.2 and 1.3 of the referenced office action. To avoid any possibly inadmissible expansions, the structure of the previous claim was maintained. However, since the two-part structure of the claim would make little sense, the claim has now only one part and is divided by features.

With respect to the objection cited under point 1.1 of the office action, please find attached a copy of

- a brochure of the fluid separating apparatus "Sediphant" according to the invention in which the essential features of the invention are described while other features, especially those of the dependent claims, are not implemented. This brochure shows the shape and structure of the channel (12) and illustrates, in particular, that this is indeed a channel in the usual sense of the term, although the area above the filter tank can of course be covered. Since this is irrelevant to the function and is furthermore not disclosed, we believe that the formulation "channel" as used is accurate.

<sup>1</sup> European Patent Attorney • <sup>2</sup> European Trademark Attorney • <sup>3</sup> Admitted before the District Court Munich I and II and the Higher Regional Court Munich

[see source for rest of footer]

The possibly somewhat unclear formulation "filter tank above the channel" was replaced by the new formulation of feature (b). The addition of the word "floor segment" makes it clear that the channel forms the floor of the filter tank. With regard to the objection of point 1.2 we have introduced a new feature (b1) which in conjunction with the changed feature (d) describes the position of the filter apparatus more precisely.

With regard to the objection of point 1.3 of the office action we refer to the change made in feature (c), which should also be considered in light of the newly introduced feature (b1).

In our view, the changed formulation of claim 1 of the invention is now described with sufficient clarity. Should the assigned Examiner have other objections regarding individual points, please contact the undersigned by phone.

For the purpose of delimitation compared to the prior art, the generic concept was limited to a fibrous material containing fluid. Please see below for the corresponding explanations.

### Novelty / Inventive Step

We concede to the Examiner that at first glance the invention and the prior art descriptions according to publications D1 and D2 appear very similar since both publications relate to separation apparatuses with a screw and a rotary filter. Functionally, however, the fluid separating apparatus according to the invention is decisively distinct from the prior art apparatuses.

With reference to D1, this publication contains four successive process steps, namely:

1. a separation material intake,
2. a conveyor screw,
3. an overflow, and
4. a rotary filter.

For this apparatus, a specific flow direction ("upstream" and "downstream") is indicated. The coarse materials are first separated in the screw and **only then**, behind an overflow weir (see figure), the fine particles are separated by the downstream rotary filter arrangement.

In contrast thereto, the separation steps in the separating apparatus according to the invention are not successive but **parallel and simultaneous**. Nor is a flow direction and sequence of the separation steps defined, since this would significantly impair the intended efficiency of the separation process.

The apparatus according to D1 on the one hand and the separating apparatus according to the invention on the other hand are therefore not suited to satisfy the requirements of the other separating apparatus, respectively. If the separating apparatus according to the invention were used in the application of D1 (separating blast furnace slag) the screw would have to ensure a clean separation between coarse and fine materials. The screw would discharge fine materials because they would settle in the standing water volume.

Conversely, the apparatus according to D1 would fail in the separation of multicomponent fluids containing fibrous materials (see page 6, line 7 of the description). The apparatus according to D1 would partly discard the light fiber-containing mat formed on the surface and at the same

time many coarse particles integrated in this mat would reach the rotary filter, so that a clean separation effect would no longer be given.

We would again like to draw attention specifically to the last paragraph of page 2 and the first paragraph of page 3. This passage notes that the special arrangement of the machine achieves a better separating action than would be possible if the individual components (and the teaching of D1 is nothing more than that) were connected in series. This, precisely, is the point of the invention.

The invention is particularly suited for multicomponent fluids **containing fibrous material**, so that the generic concept of claim 1 was limited. This limitation is covered by the description, page 1, lines 21-22, page 6, lines 7 and 33.

Accordingly, the **object** of the invention is worded more precisely in that the aim is to improve the separation into three different fractions of a fibrous material containing fluid.

The embodiment according to printed publication **D2** is distinguished from the separating apparatus according to the invention in the same way as the apparatus according to D1. Here, too, the separation steps are carried out successively, although in reverse sequence—first the rotary filter unit is charged and subsequently the screw. The screw, in this embodiment, is purely a conveyor screw for discharging the thick stock from the rotary filter. This apparatus has only two outlets (filtrate and thick stock) and is thus fundamentally distinct in its function from both the separating apparatus according to the invention and the apparatus according to D1.

In consequence, the fluid separating apparatus according to the invention as set forth in the revised claim 1 and based on the above-described object involves an inventive step compared to the prior art.

#### Adaptation of the Description

The enclosed description pages are intended to replace the original description pages 1-3. The publications D1 and D2 have been acknowledged and the object has been adapted to the above formulation. Finally, the figure description of Figure 7 has been completed.

#### Enclosures